

No. 9327

IN THE  
United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT

---

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

*Appellant,*

*vs.*

WILLIAMS-WALLACE COMPANY, a corporation,

*Appellee.*

---

APPELLANT'S BRIEF.

---

LYON & LYON,  
FREDERICK S. LYON,  
R. E. CAUGHEY,

811 West Seventh Street Building, Los Angeles,  
*Attorneys for Appellant.*



## TOPICAL INDEX.

	PAGE
Introduction .....	1
Jurisdiction .....	1
Statement of the Case.....	2
Specification of Errors Relied Upon.....	11
Summary of Argument.....	14
Argument .....	18
The Stadtfeld Patent as Granted Is Wholly Void.....	18
The Disclaimer Is Invalid and With the Invalid Disclaimer Fall the Patent Claims.....	18
The Patent Is Void Because Appellee Unreasonably Neglected and Delayed in Filing the Disclaimer. There Was No "In- advertence, Accident, or Mistake" in Stadtfeld's Asserting and Procuring the Grant of the Patent Claims; Said Claims Were Secured With the "Fraudulent and Deceptive Inten- tion" Within the Meaning of the Disclaimer Statute.....	36
The Patent Is Invalid Because by the Purported Disclaimer Appellee Has Attempted to Claim and Monopolize as the Patentable Invention the Subject-Matter of Claims Which Were Presented in the Application, Rejected and Cancelled, Whereby Appellee Became Estopped to Thereafter Assert Such Subject-Matter as Patentable Invention by Stadtfeld	40
The Mere Selection of the Old, Well Known Composite Pipe Construction of Patent Claims 1, 2 and 3 and the Selec- tion or an Addition Thereto of the Old, Well Known Crimped Ends Forming Leak Proof Joints Was Mere Mechanical Skill and Cannot Amount to Invention. ( <i>Ray v. Bunting Iron Works - supra</i> ).....	41
Conclusion .....	47

TABLE OF AUTHORITIES CITED.

	BRIEF APP'X	
CASES.	PAGE	PAGE
Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390, 70 L. ed. 651.....	41	
Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U.S. 477, 479, 480, 488, 490, 491, 492, 79 L. ed. 1005, 1008, 1013, 1014, 1015.....	14, 15, 21, 32, 33, 34, 35, 47	8
American Lakes Paper Co. v. Nekoosa-Edwards Paper Co., et al., 83 F. 2nd 847 (C.C.A. 7).....	33	10
Carson v. American Smelting & Ref. Co., 4 F. 2nd 463, 469 (C.C.A. 9).....	31	
Corn Products Ref. Co. v. Penick & Ford, 63 F. 2nd 26, (C.C.A. 7).....	33	15
Ensten v. Rich-Sampliner Co., 13 F. 2nd 132, 136.....	38	
Ensten v. Simon Ascher & Co., 282 U.S. 445, 452-3, 75 L. ed. 453, 456, 457.....	18, 37	
Fruehauf Trailer Co. v. Highway Trailer Co., 54 F. 2nd 691 (D.C. Mich.).....	33	
Fruehauf Trailer Co. v. Highway Trailer Co., 67 F. 2nd 558 (C.C.A. 6).....	33	13
General Motors Corp. v. Rubsam Corp., 65 F. 2nd 217 (C.C.A. 6) .....	33	
Grinnell Washing Mach. Co. v. E. E. Johnson Co., 247 U.S. 426, 62 L. ed. 1196.....	40	
Hailes v. Albany Stove Co., 123 U.S. 582, 31 L. ed. 284, 286 .....	21	
Hailes v. Van Wormer, 87 U.S. 353, 22 L. ed. 241.....	40	
Henry v. Los Angeles, 255 F. 769, 780 (C.C.A. 9).....	21	
Hertz Driveurself Stations v. Ritter, 91 F. 2nd 539, 543 (C.C.A. 9) .....	14	
Keystone Driller v. Northwest E. Corp., 294 U.S. 42, 50, 79 L. ed. 747, 752.....	40	
Lowell v. Triplett, 17 F. Supp. 996.....	33	13

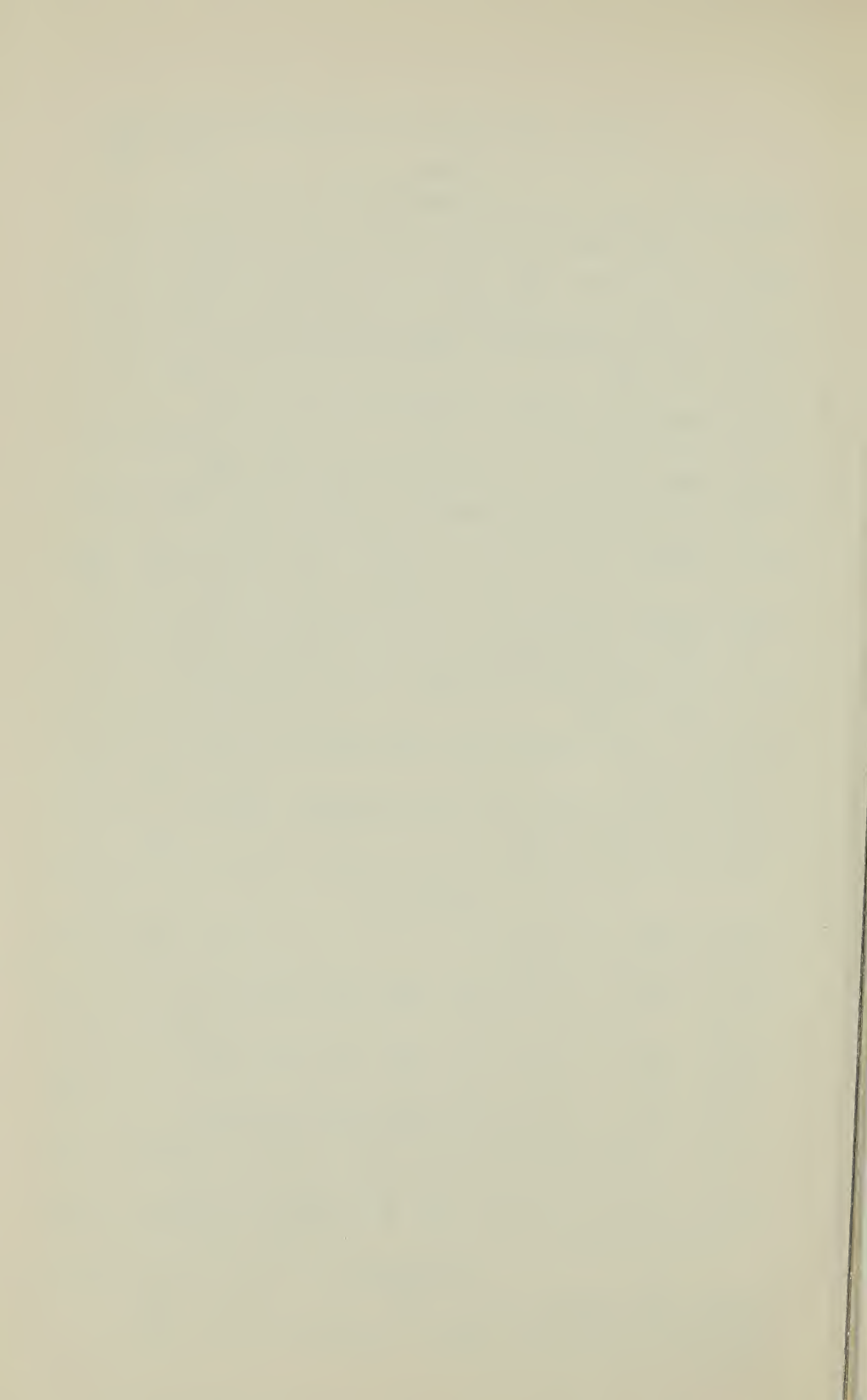
CASES.	PAGE	PAGE
McCarty v. Lehigh Valley Railroad, 160 U.S. 110, 116, 40 L. ed. 358, 361.....	34	
Mettler v. Peabody Eng. Corp., 7 F. 2nd 56, 58 (C.C.A. 9) .....	41	
Motion Picture Patents Co. v. Universal Film M. Co., 243 U.S. 502.....	21	
Otis Elevator Co. v. Pacific Finance Corp., 68 F. 2nd 665, 670 (C.C.A. 9).....	36	
Powers-Kennedy Corp. v. Concrete M. & C. Co., 282 U.S. 175, 186, 75 L. ed. 278, 286.....	40	
Ray v. Bunting Iron Works, 4 F. 2nd 214 (C.C.A. 9).... .....	17, 41, 47, 48	18
Union Metallic Cartridge Co. v. U.S. Cartridge Co., 112 U.S. 624, 28 L. ed. 828.....	21	
U. S. Peg Wood, S. & L. B. Co. v. B. F. Sturtevant Co., 122 F. 470.....	35	
Wilson v. Byron Jackson Co., 93 F. 2nd 572, 575 C.C.A. 9) .....	14	
Wilson & Willard Mfg. Co. v. Union Tool Co., 249 F. 729, 735 (C.C.A. 9).....	40	

## STATUTES.

Judicial Code, Sec. 41.....	1	
Judicial Code, Sec. 129.....	1	
Revised Statutes United States 4888 (35 USCA, Sec. 33) .....	20, 21	7
Revised Statutes United States 4899 (35 USCA, Sec. 48) .....		8
Revised Statutes United States 4916 (35 USCA, Sec. 64) .....	20, 22	6
Revised Statutes United States 4917 and 4922 (35 USCA, Secs. 65, 71).....	8, 14, 18, 19, 20, 36	5

## TEXTBOOKS.

Robinson on Patents, Vol. 1, p. 284.....	37
Rules of Civil Procedure, Rule 15, subd. (b).....	14



No. 9327

IN THE

**United States Circuit Court of Appeals**  
FOR THE NINTH CIRCUIT

---

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

*Appellant,*

*vs.*

WILLIAMS-WALLACE COMPANY, a corporation,

*Appellee.*

---

**APPELLANT'S BRIEF.**

---

Appellant, Payne Furnace and Supply Company, Inc., appeals from an interlocutory decree of the District Court for the Northern District of California granting an injunction prohibiting appellant's manufacture, use or sale of composite pipe embodying the alleged invention of patent 2,013,193.

**Jurisdiction.**

No question of jurisdiction or pleading is raised by the appeal herein. The suit arises under the patent laws, of which the District Court has exclusive original jurisdiction (*Judicial Code*, §41).<sup>\*</sup> Appellant appeared and answered [I. 44, 23-40]. The appealed decree was filed June 13, 1939 [I. 65].<sup>†</sup> The notice of appeal was filed July 12, 1939, within thirty days (*Judicial Code*, Sec. 129).

---

<sup>\*</sup>"The district courts shall have original jurisdiction as follows: \* \* \* Seventh. Of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws." (*R. S.* §629; *28 USCA*, pp. 32-33.)

<sup>†</sup>Herein the Roman numeral refers to the volume of the Record and is followed by the page number.



### Statement of the Case.

On July 27, 1936 [I. 1-6] appellee, Williams, Wallace Company, filed its complaint in the United States District Court for the Northern District of California against Payne Furnace and Supply Company, *Inc.*, a corporation. Appellee intended thereby to name as the defendant appellant's predecessor in business, *Payne Furnace and Supply Company*. This appears from a stipulation amending the complaint by changing the name of the defendant by cancelling therefrom "Inc." [I. 45]. In its said complaint appellee alleged invention by Jacob A. Stadtfeld "of certain new and useful improvements in Composite Pipe Construction"; the grant of the patent in suit No. 2,013,193 therefor, and the alleged infringement thereof by the defendant [I. 1-6]. The "Transcript of Record" herein does not disclose certain procedural steps and facts which are deemed by the respective parties to be immaterial to this appeal, (to wit: the filing of the original answer to said complaint), because such answer was superseded by an amended answer thereafter filed. On June 14, 1937, appellee filed a "SUPPLEMENTAL BILL OF COMPLAINT" bringing in *appellant, Payne Furnace and Supply Company, Inc.*, as a party-defendant, alleging therein that appellant had acquired the business, assets, and good will of the original defendant, Payne Furnace and Supply Company, and that appellant was infringing said Stadtfeld patent, etc., and seeking an injunction and accounting of profits and damages against appellant [I. 21-23]. The



record discloses that on June 18, 1937, the original defendant, Payne Furnace and Supply Company, filed its "FIRST AMENDED ANSWER AND COUNTER-CLAIM" responsive to the original complaint [I. 23-40]. In August, 1937, the parties stipulated that said first amended answer filed June 18, 1937, on behalf of defendant, Payne Furnace and Supply Company, shall be and is adopted also as the answer of appellant [I. 44]. As hereinbefore pointed out, the original complaint [I. 1-6] was entitled against Payne Furnace and Supply Company, Inc., a corporation. To correct the error in naming the defendant to the original complaint, the parties entered into said stipulation [I. 45] striking "*Inc.*" from the name of the defendant in the title and stipulated that in all other papers filed by appellee where the name of the original corporate defendant is given as "Payne Furnace and Supply Company, Inc., a corporation, it shall be deemed to be Payne Furnace and Supply Company, a corporation, except that the name of the defendant corporation joined herein by plaintiff's supplemental bill of complaint filed herein on the ..... day of June, 1937, as successor to the original defendant, is correctly given as Payne Furnace and Supply Company, Inc." [I. 45].

The so-called first amended answer filed June 18, 1937 [I. 23-40] so constituted the answer on behalf of this appellant by said stipulation [I. 44]; it denied that Stadtfeld made any invention [Par. IV. — I. 24-25] and affirmatively alleged want of invention [Par. XIII. — I. 33] and anticipation [Par's X. and XI. — I. 29-31] and public

use by sundry parties [Par. XII. —I. 31-33]. Said answer further alleged that appellee is estopped to maintain this suit for the reason that this appellant has a license and shopright to make, use and sell vent pipe like that shown and described in the patent in suit [Par. XX. —I. 36-39]. The appeal herein does not seek a review of the District Court's determination against appellant of this defense of license or shopright.

Except as above pointed out, the Transcript of Record herein does not disclose that the suit was ever concluded with respect to the original defendant, Payne Furnace and Supply Company; on the contrary, the record indicates by its absence of any reference to such original defendant, Payne Furnace and Supply Company, that the District Court, and appellee, as well as appellant, simply ignored said Payne Furnace and Supply Company as a defendant. The appealed decree refers solely to and is solely against appellant, Payne Furnace and Supply Company, Inc. [I. 63-65]. Said interlocutory decree even in the heading or caption thereof does not name or refer to the original defendant, Payne Furnace and Supply Company, in any manner, but names appellant, Payne Furnace and Supply Company, Inc., a corporation, as the sole defendant. The "NOTICE OF APPEAL" [I. 66] does not mention said original defendant, but is that "defendant, Payne Furnace and Supply Co., Inc., does hereby appeal".

The appeal herein raises no question for review, and seeks no review, respecting the foregoing procedural mat-

ters which are referred to solely as explanatory of the record.

The Stadtfeld patent in suit refers to “improvements in composite pipe constructions of the kind used in conveying gases or fluids.” [III. 637, col. 1, *ll.* 1-3]. The patent states:—

“An object of my invention is to provide an improved composite pipe construction consisting of an inner core pipe of non-corrosive material, an outer metallic pipe or casing spaced from the inner core pipe, and an intermediate filler of air cell heat insulating material interposed between the inner and outer pipes.” [Id. *ll.* 4-10.]

The provision of an inner pipe of non-corrosive material, (such for example as aluminum), an inner filler of air cell heat insulating material, and an outer metallic pipe (such as galvanized iron), was the subject of application claim 1 which was rejected by the Patent Office and cancelled [III. 694].

The third paragraph of the Stadtfeld patent specification states that another object of the invention is to provide an improved composite pipe construction in which the inner core pipe is *telescopically* arranged with respect to the outer pipe and the insulating material [III. 637, col. 1, *ll.* 11-15]. The three patent claims call for a composite pipe construction comprising an outer tube, one or more layers of insulating material located around the inside surface of said tube, and an inner tube *slidably* or *telescopically* located inside the insulating material.

The Stadtfeld patent states a further object of the invention:

“is to provide an improved composite pipe construction of the type characterized having end fittings which provide leak proof joints at the joined ends of a number of sections, whereby condensates collecting on the inside surface of the inner pipes are prevented from leaking through their joints to the outside thereof and water running down the outside surface of the outer pipes is prevented from proceeding through their joints to the inside thereof.”

[*Id.* *ll.* 16-26.]

The leak proof joints so provided at the ends of the sections are formed by crimping the ends of the pipes, so that the ends will fit one within the other, and turning the inner smaller or female crimped end upward so that water running down the outside surface of the outer pipes is carried over the joint and prevented from entering the joint to the inside of the pipe. Application claims 3, 4, and 5 [III. 694] and additional claim 8 [III. 698] were addressed to the combination of a plurality of composite pipe sections having these leak proof joints, etc. These application claims 3, 4, 5, and 8 were rejected [III. 697,701] and cancelled [III. 698, 709] as anticipated by the prior patents to Line 690,744 and Bradbeer 390,438.

On February 25, 1938, (8 months and 7 days after the Amended Answer herein was filed), appellee filed in the U. S. Patent Office a purported disclaimer of the claims of the Stadtfeld patent [III. 638]. When appellee first presented this purported disclaimer to the District Court, appellant objected thereto [I. 210] and excepted to its receipt in evidence [I. 211]. Subsequently a certified copy of the disclaimer was received and it was sub-

stituted for the uncertified copy of such disclaimer (so offered as Plffs. Ex. 1-A) and is not printed in the record for the reason that the printed copy of the Stadtfeld patent [Plffs. Ex. 1 – III. 635-38] in accordance with the practice of the United States Patent Office has printed at the end thereof the purported disclaimer [III. 638]. For clarity appellant points out that it admits and does not raise any question respecting the fact that this purported disclaimer was filed in the United States Patent Office on February 25, 1938; that it is correctly reproduced at the end of said copy of said Stadtfeld patent; that there is no issue raised whatsoever as to the form or adequacy of execution by appellee of said purported disclaimer or of appellee's ownership of the patent at the time of the filing of such purported disclaimer.

No amendment was ever made to the complaint to plead the filing of the purported disclaimer, nor was there ever filed any additional or amended answer respecting such disclaimer. The case was heard and determined by the District Court as though grounded upon a cause of action for infringement of the Stadtfeld patent as modified by the purported disclaimer. The District Court found [finding 7 – I. 51]:—

“The claims of the patent in suit were narrowed in scope by qualifying disclaimers filed in the United States Patent Office on February 25, 1938, pursuant to U. S. Revised Statute Section 4917, when it appeared to plaintiff that through inadvertence, accident or mistake their language was of undue breadth, and permitted an interpretation broader than was intended. Each limitation was taken directly from the specification of the patent as originally filed and each only modifies the three elements of the claims without adding new elements.”



As a conclusion of law the District Court found [I. 62] :-

“1. Claims 1, 2, and 3 (with disclaimers) of Stadtfeld Patent No. 2,013,193, and each of them, are good and valid in law.”

The appeal herein does not seek review of or question the correctness of the *procedure* of the District Court in determining the issues of said case so founded upon the purported cause of action for infringement of said Stadtfeld patent as modified by the purported disclaimer. Appellant seeks solely a review of the District Court's determination of the issues of validity of the patent.

The filing of the disclaimer presented four questions of law:

(1) Was the purported disclaimer such a disclaimer as is authorized by statute? (R. S. U. S. 4917 & 4922 - 35 USCA, Secs. 65 & 71.) Did such disclaimer excind any material or substantial part of the thing patented?

(2) Does the disclaimer, instead of excinding a material or substantial part of the thing patented, attempt to interpolate into the patent claims additional elements not comprised in the combination specified by said patent claims 1, 2 and 3 or in law attempt to restate the patented combination by adding other elements thereto, thereby creating a different combination of elements from that patented?

(3) Is the Stadtfeld patent void because appellee unreasonably neglected and delayed in filing said disclaimer and because there was no inadvertence, ac-

cident or mistake in the making of the original claims, but such claims were solicited and secured with “fraudulent and deceptive intention” within the meaning of the disclaimer statute?

This combined question arises upon the undisputed proofs that Stadtfeld before he filed his application for the patent knew of the prior patents, etc., anticipatory of the solicited and patented claims, and that appellee itself was placed on notice of such anticipatory patents, etc., by appellant’s answer pleading such patents, etc., June 18, 1937,—8 months and 7 days before the disclaimer was filed.

The District Court made no findings and no conclusion of law with respect to either the issue of unreasonable neglect or delay in filing the disclaimer or the question of “fraudulent and deceptive intention” in originally making the claims of the patent.

(4) Is the patent invalid because by said purported disclaimer appellee has attempted to “point out and distinctly claim” as the patentable invention the subject-matter of claims which were presented in the application for said letters patent and which claims were rejected by the Patent Office and cancelled by the applicant in view of such rejection, whereby appellee became estopped to thereafter assert such subject-matter was or is patentable as invention by said Stadtfeld?

This fourth question is one of law arising on the record of the proceedings in the Patent Office in negotiating the grant of the patent and is not the subject of oral testimony.



Appellant's answer alleged [Par. XV. – I. 34] that Stadtfeld

“so limited and confined the claims of said application, by, under, and pursuant to the requirements of the Commissioner of Patents, and by the acquiescence in, rejection of, and cancellation of claims, both in view of the prior art and otherwise, and so admitted the limited scope of said purported invention, if, in fact, any invention had been made, which is denied, that he cannot now seek to obtain a construction of the validity claims of said Letters Patent here in issue, or a construction sufficiently broad or of such scope as to include within the purview thereof any mechanisms or devices manufactured, used, or sold by this defendant, \* \* \*.”

This allegation of said Par. XV. of appellant's answer is supported in the record by the certified copy of the file history of the application for the Stadtfeld patent wherein the claims presented by Stadtfeld, rejected by the Patent Office, and cancelled in view of such rejections, fully appear as a matter of record.

In addition to the foregoing four questions of law presented by the disclaimer there is a fifth and final question presented by the record:—

If said purported disclaimer can be sustained under the disclaimer statutes, are said claims 1, 2 and 3 as so restated thereby, void for want of invention and anticipation?

This question arises and is presented on the record by appellant's pleading in its answer [Pars. 10 & 11 – I. 29-31; Par. XV. – I. 34] and the documentary proofs (prior patents, etc.) and oral evidence presented by the record.

### Specification of Errors Relied Upon.

(1) The District Court erred in granting the injunction herein decreed [Par. 5, Interlocutory Decree – I. 65; Notice of Appeal – I. 66].

(2) The District Court erred in ordering, adjudging and decreeing:

“1. That United States Letters Patent No. 2,013,193, granted September 3, 1935, to Williams-Walace Company, Plaintiff, as assignee of Jacob A. Stadtfeld, for Composite Pipe Construction, is good and valid in law as to claims 1, 2 and 3 thereof.”

[I. 63-64.]

(3) The District Court erred in its conclusion of law that:

“1. Claims 1, 2, and 3 (with disclaimers) of Stadtfeld Patent No. 2,013,193, and each of them, are good and valid in law.” [I. 62.]

(4) The District Court erred in its finding that:

“7. The claims of the patent in suit were narrowed in scope by qualifying disclaimers filed in the United States Patent Office on February 25, 1938, pursuant to U. S. Revised Statute Section 4917, when it appeared to plaintiff that through inadvertence, accident or mistake their language was of undue breadth, and permitted an interpretation broader than was intended. Each limitation was taken directly from the specification of the patent as originally filed and each only modifies the three elements of the claims without adding new elements.” [I. 51.]

Said finding is in error in law. The claims as restated by the disclaimers covered and embraced a different combination of elements from the

combination of elements embraced within the respective patent claims 1, 2 and 3. The claims were not “narrowed” by the disclaimers,—this is an erroneous statement of law. The finding is further erroneous if it is to be interpreted as a finding that there was any inadvertence, accident or mistake as contrary to the uncontradicted proofs.

(5) The District Court erred in not finding, adjudging and decreeing that said Stadtfeld patent is invalid because appellee unreasonably neglected and delayed in filing said disclaimer.

The District Court made no finding respecting unreasonable neglect or delay in filing the disclaimer.

(6) The District Court erred in not finding, adjudging and decreeing that said Stadtfeld patent is invalid because the original granted patent claims were asserted and procured with fraudulent and deceptive intention and will full knowledge of said Stadtfeld and appellee that said Stadtfeld was not the inventor of the combination claimed in said respective claims.

The District Court made no finding whatsoever on this issue.

(7) The District Court erred in its finding No. 7 that there was any inadvertence, accident or mistake on the part of either Stadtfeld or appellee respecting the patent claims 1, 2 or 3. The uncontradicted testimony is that Stadtfeld had before him prior to making his application

for the patent in suit the prior patents, (including the O'Toole patent 878,014—Defts. Ex. 4-E), and that appellee was put upon notice thereof as early as June 18, 1937.

(8) The District Court erred in not adjudging and decreeing that said Stadtfeld patent 2,013,193 is void because by said purported disclaimer appellee has thereby attempted to claim as the patentable invention the subject-matter of claims which were presented in the application for said letters patent, rejected by the Patent Office and cancelled by Stadtfeld, whereby appellee became estopped to thereafter assert such subject-matter as patentable invention by said Stadtfeld.

(9) The District Court erred in not adjudging and decreeing that claims 1, 2 and 3 of said Stadtfeld patent as modified by said disclaimer are void for want of invention.

The foregoing specification of errors will be found to be fully covered by appellant's "CONCISE STATEMENT OF POINTS UNDER RULE 19(6) OF THIS COURT" [II. 616-20], which for the Court's convenient reference thereto (if desired) we have printed at the opening of the Appendix hereto. Appellant submits its appeal herein to be determined upon the foregoing Specification of Errors and will not present any other of said "Concise Statement of Points Under Rule 19(6) of This Court" except to such extent as consideration thereof may be incidental (if at all) to a determination of the errors so specified.

### Summary of Argument.

1. The case was tried and determined by the District Court as though the pleadings had been amended to join issue upon the legality and effect of the disclaimer. Under these circumstances this Court will deem the formal pleadings to have been amended to conform to the evidence (*Hertz Driveurself Stations v. Ritter*, 91 F. 2nd 539, 543 – C.C.A. 9; *Wilson v. Byron Jackson Co.*, 93 F. 2nd 572, 575 – C.C.A. 9). *Rule 15, subdivision (b) R. C. P.* now provides that failure to amend to correspond to proofs does not affect the result of the trial of these issues.

2. The purported disclaimer is invalid and the whole patent falls with the invalid disclaimer. Said disclaimer does not disclaim or excind a “material or substantial part of the thing patented” (*R. S. U. S. Secs. 4917 & 4922 – 35 USCA, Secs. 65 & 71*). On the contrary, said disclaimer attempts “in effect (to) secure a new patent operating retroactively in a manner not permitted by the reissue statute and without subjecting the new claims to revision or restriction by the customary Patent Office procedure required in the case of an original or re-issued patent” (*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, 491, 79 L. ed. 1005, 1014). Instead of excinding a material or substantial part of the thing patented, said disclaimer attempts to interpolate into the patent claims additional elements not comprised in the combination specified by said patent claims 1, 2 or 3. The patent is invalid because by said purported disclaimer ap-



pellee has restated the operative parts of the patent (i. e., the claims) to call for and embrace a different combination of elements from the combination of elements called for by the respective patent claims. The disclaimer statute “does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination” (*supra*, 294 U. S. 490, 79 L. ed. 1014).

The attempted disclaimer being invalid, the original claims and the patent as it stood before the disclaimer fall as invalid (*supra*, 294 U. S. 492, 79 L. ed. 1015).

3. The patent is void because appellee unreasonably neglected and delayed in filing the disclaimer. The Stadtfeld patent issued September 3, 1935 [III. 637]. This suit was filed July 27, 1936 [I. 6]. Appellant’s answer was filed June 18, 1937, and put appellee upon notice as of that date of the O’Toole, Savage, Aldrich, Meade, Hammill and Welch patents [I. 30-31]. Furthermore, Stadtfeld *before* November 3, 1934 (the date of filing his application for the patent in suit) had the O’Toole and other patents directly called to his attention [Stadtfeld – II. 544; Payne – II. 610].

There was no “inadvertence, accident, or mistake,” in Stadtfeld’s or in appellee’s asserting and securing the grant of the patent claims, but these were secured with a “fraudulent and deceptive intention” within the meaning of the disclaimer statute. Both Stadtfeld and appellee were cognizant of and put upon notice of the O’Toole

and other patents showing the combination of the patent claims to be old and not Stadtfeld's invention.

4. The patent is invalid because by the purported disclaimer appellee has attempted to claim and monopolize as the patentable invention the subject-matter of claims which were presented in the application for said letters patent and which were rejected by the Patent Office and cancelled and withdrawn by the applicant in view of such rejection, whereby appellee became estopped to thereafter assert such subject-matter was or is patentable as the invention by said Stadtfeld. Application claims 3, 4, 5 [III. 694] and additional application claim 8 [III. 698] embraced and distinctly pointed out and claimed the "end fittings which provide leak proof joints at the joined ends of a number of sections," of the fourth paragraph of the specification of the Stadtfeld patent [III. 637, col. 1, *ll.* 16-25]. The addition of these "end fittings which provide leak proof joints at the joined ends of a number of sections," is one of the additional elements unlawfully attempted to be interpolated by the disclaimer into the patent claims.

5. Even if said purported disclaimer can be sustained as valid, claims 1, 2 and 3 of the Stadtfeld patent as restated thereby are void for want of invention.

(a) By the disclaimer appellee not only admits, but asserts that it was not a novel invention by Stadtfeld to make a composite pipe of an outer tube, and an inner tube slidably or telescopically located inside one or more layers of insulating material located inside the outer pipe.



(b) Appellee is estopped from contending that it was invention to provide a combination consisting of a composite pipe construction having the leak proof male and female ends [cancelled application claim 3—III. 694] or comprising a plurality of sections joined together, each section formed with crimped ends, an outer crimped end fitting over the inner crimped end (termed male and female fittings) to form leak proof joints [cancelled application claim 8—III. 698].

(c) The mere selection of the old, well known composite pipe construction of Par. (a) just above stated, and the addition thereto of the old well-known leak proof joints of Par. (b) just above stated, cannot amount to invention, but is:

“The selection and putting together of the most desirable parts of different machines in the same or kindred art, making a new machine, but in which each part operates in the same way as it operated before and effects the same result, (and) cannot be invention; such combinations are in the nature of things the evolutions of the mechanic’s aptitude rather than the creations of the inventor’s faculty.’ Huebner-Toledo Breweries Co. v. Mathews Gravity Carrier Co., 253 F. 435, 447, 165 C.C.A. 177, 189.”

(*Ray et al v. Bunting Iron Works*, 4 F. 2nd, 214—C.C.A. 9.)

## ARGUMENT.

### The Stadtfeld Patent As Granted Is Wholly Void.—

The well established general rule is that a patent with an invalid claim is wholly void (*Ensten v. Simon Ascher & Co.*, 282 U. S. 445, 452, 75 L. ed. 453, 456). As we shall hereafter develop, appellee has admitted that claims 1, 2 and 3 of the patent are each invalid.

### The Disclaimer Is Invalid and With the Invalid Disclaimer Fall the Patent Claims.—

To modify the harshness of the foregoing legal principle, Congress enacted *R. S. U. S. 4917 and 4922 (35 USCA, Secs. 65 and 71)* [Appendix, pp. 5-6]. These two sections “are parts of one law having one general purpose, and that purpose is to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it.” (*Esten v. Simon Ascher & Co. — supra*). “Construed together, they ‘enact that where a patentee claims materially more than that which he was the first to invent, his patent is void, unless he has preserved the right to disclaim the surplus; and that he may fail to preserve that right, by unreasonable neglect or delay to enter a disclaimer in the Patent Office.’” (*idem*). “The statute is remedial; the intent is to aid the inventor free from wilful default or intention to mislead the public by permitting him to avoid the consequence of inadvertence, acci-

dent or mistake through prompt disavowal of the apparent right to exclude others from something improperly included in the words of his grant. Escape is permitted only to one who acted originally in good faith and who has complied with the prescribed conditions.” (*idem*).

It is clear therefore that this statute does not require a disclaimer. It permits a disclaimer in certain cases only. By availing himself of the permission of the disclaimer statute the patentee may escape the result of having claimed more than was his invention, provided this resulted from “inadvertence, accident, or mistake, and without any fraudulent or deceptive intention” (*R. S. U. S. 4917-35 USCA, Sec. 65*). *R. S. U. S. 4922 (35 USCA, Sec. 71)* expresses this in slightly different words: “through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public.” If, however, the patentee does not act promptly and bring himself within this remedial statute he may lose the entire patent. It is a privilege which is accorded to him, of which he must avail himself promptly.

Both sections of this statute contemplate that a disclaimer is proper only when a patentee has claimed more than that of which he was the inventor and permit only a disclaimer of “a material or substantial part of the thing patented, of which he was not the original and first inventor” (*R. S. U. S. Sec. 4922*) or, as expressed in *Section 4917*, “make disclaimer of *such parts of the thing patented* as he shall not choose to claim or to hold by virtue of the patent” (emphasis ours). The statute does not

authorize the use of a disclaimer to revise or revamp a granted patent. Appellee has disclaimed, and such disclaimer in law must be predicated upon an admission that some *thing claimed* by the patent was not the invention of Stadtfeld. A disclaimer cannot be used as a mere amendment of the patent. Only by a reissue of the patent under R. S. U. S. 4916—35 USCA, Sec. 64— [Appendix, p. 6] can an amendment be made. By filing a disclaimer the patentee recognizes and acknowledges that the thereby excinded part of the thing patented was not his invention. It is not material who other than the patentee was the original or first inventor of the thing claimed by the patent and excinded by the disclaimer. The material fact is that the patentee by disclaimer so recognizes this fact and excinds from the patent the part claimed therein (i. e., “the part, improvement, or combination which he claims as his invention or discovery”— R. S. U. S. 4888, 35 USCA, Sec. 33— [Appendix, pp. 7-8] which was the invention of someone else at some previous time. Under *Sections 4917 and 4922* the material fact is that the excinded part must be a separate and divisible part, so that what is retained amounts to invention over what is excinded. This logically follows because by the disclaimer the patentee voluntarily confesses that he was not the original or first inventor or discoverer of the excinded part. Looking further at *Section 4922* in particular, it is seen that the part retained must be “a material and substantial part of the *thing patented*,” “definitely distinguishable from the parts

claimed without right.” There are two requirements: (1) that the part retained shall be a material, substantial *part of the thing patented*, and (2) that such part of the thing patented shall be definitely distinguishable from the part or parts disclaimed. The *thing patented* is the thing (in the case at bar, the “combination”) “particularly point(ed) out and distinctly claim(ed)” (*R. S. U. S. 4888, 35 USCA, Sec. 33*). It is too well settled to require the citation of numerous authorities that that which is patented is that which is particularly pointed out and distinctly claimed in the claims. (*Cf. Altoona Publix Theatres v. American Tri-Ergon Corp. —supra; Motion Picture Patents Co. v. Universal Film M. Co.*, 243 U. S. 502; *Henry v. Los Angeles*, 255 F. 769, 780—C.C.A. 9.) We repeat,—under this disclaimer statute, to be a valid disclaimer the part retained (1) must have been claimed (i. e., “patented”) in the patent as granted; and (2) must be *definitely distinguishable from the parts disclaimed*. The disclaimer statute “expressly limits a disclaimer to a rejection of something before claimed as new” (*Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U. S. 624, 28 L. ed. 828; “\* \* \* certainly it cannot be used to change the character of the invention” (*Hailes v. Albany Stove Co.*, 123 U. S. 582, 31 L. ed. 284, 286).

It was the obvious intention of appellee to avail itself of the permission of this remedial statute. Appellee’s disclaimer must be read in the light of this statute and appellee cannot now be heard to assert that its disclaimer



is not based upon the fact that something claimed by the patent was not the invention of Stadtfeld.

Under this disclaimer statute the Commissioner of Patents performs a purely ministerial duty,—limited to making a record of the purported disclaimer after determining that the disclaimer has been properly executed by the then owner or owners of the patent as shown by the title books of the Patent Office. Contrast this provision with the authority and duty of the Commissioner of Patents under the reissue statute (*R. S. U. S. 4916–35 USCA, Sec. 64*) under which he may refuse an amended or reissued patent and may reject the new claims for lack of patentable novelty, lack of invention, anticipation, etc.

In testing the validity of the disclaimer, the question of law therefore is presented: Is the so-called disclaimer within the statutory right and obligation, or is it an unlawful attempt to obtain an amended or reissued patent while avoiding the scrutiny of the Patent Office and the latter's examination and determination of the patentable novelty, etc., of the new claims formulated by such disclaimer? It is appellant's position that instead of the purported disclaimer excinding anything claimed or patented by the patent claims, the disclaimer (1) attempts to make additional structural elements parts of the combination of the patent claims; (2) to change the character of the claims from a composite pipe construction to a sectional pipe construction by including a plurality of sections within each claim; and (3) to claim a different "combination" from the combination patented by the patent

claims. That thereby appellee has attempted, under the guise of the disclaimer statute, to secure a reissue or amended patent and to avoid the requirements of the reissue statute, including the making of formal application for the reissue, accompanied by the payment of government fees, and including also the requisite oath as to inadvertence, accident and mistake and negating any fraudulent or deceptive intention.

Obviously the purported disclaimer is not an excision of any part of any claim. It is not an excision from any claim of any part of the thing patented. It is not an excision from the descriptive matter of any alternative construction or equivalent. In fact, it is not an excision of anything.

The patent as granted contained three claims, each for a combination, to wit: "A composite pipe construction." Such composite pipe construction is defined (claims 1 and 2) as "comprising an outer tube \* \* \* and an inner tube slidably located inside the insulating material", the third element of the combination being one or more layers of insulating material located between the inner and outer tubes which are slidable one within the other. Claim 3 is substantially the same as claims 1 and 2, differing therefrom only in that it uses the term "telescopically", instead of "slidably" as used in claims 1 and 2. The combination so defined does not include and is in no manner dependent upon or concerned with such composite pipe being made in sections or whether each section shall be provided with means for connecting the sections together, much less an alleged newly invented connecting



means providing leak proof joints. The distinction between the claims as granted in the patent and the restatement thereof by the disclaimer is made clear by the following comparison:

*The Patent Claims.*

CLAIM 1.

A composite pipe construction

comprising

(a) an outer tube,

(b) one or more layers of insulating material located around the inside surface of the said tube, and

(c) an inner tube slidably located inside the insulating material.

*The "Disclaimer" Claims.*

CLAIM 1.

Composite sectional pipe for conducting fluids or gases of combustion

comprising

(a) an outer tube,

(b) one or more layers of insulating material located around the inside surface of the said tube,

(c) an inner tube slidably located inside the insulating material,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said

*The Patent Claims.*

CLAIM 1.

*The "Disclaimer" Claims.*

CLAIM 1.

inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally there-through.

*The Patent Claims.*

CLAIM 2.

A composite pipe construction

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube, and

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material.

*The "Disclaimer" Claims.*

CLAIM 2.

Composite sectional pipes for conducting fluids or gases of combustion

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube.

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower sec-

*The Patent Claims.*

CLAIM 2.

*The "Disclaimer" Claims.*

CLAIM 2.

tion so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally there-through.

*The Patent Claims.*

CLAIM 3.

A composite pipe construction

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe, and

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another.

*The "Disclaimer" Claims.*

CLAIM 3.

Composite sectional pipes for conducting fluids or gases of combustion.

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe,

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located



*The Patent Claims.*  
CLAIM 3.

*The "Disclaimer" Claims.*  
CLAIM 3.

inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship.

(g) and the insulating material interposed between the two pipes provides an intermediate filler.

The foregoing comparison of the patent claims as granted and the purported disclaimer's re-statement and re-construction of claims makes clear:—

*The Patent Claims.*—These clearly define as the invention patented a single length of composite pipe construction comprising three elements only, —(a), (b) and (c). They do not in any manner indicate,—much less “particularly point out and distinctly claim,”—that the invention resides in providing sectional composite pipes, nor that the invention includes mechanical means,—much

less a specific form and interrelation of mechanical means,—for joining the lengths of pipe or sections together, or that such joining or connecting means are of such form or construction as to provide leak proof joints between the adjoining sections. There is absolutely nothing in the patent claims which even hints at, much less, “particularly point(s) out and distinctly claim(s)”, that the patented invention is in any degree whatsoever dependent upon (1) the formation of a leak proof joint between sections of pipe, or (2) that such leak proof joint is made by the provision of male and female fittings, or (3) that the completed joint between adjacent ends of adjoining sections of the inner and outer pipes is in substantial radial alignment, or (4) that by the leak proof joints, so formed by male and female fittings, etc., each string of connected pipe is independently supported or maintained in connected relationship.

*The Disclaimer Claims.*—These attempt to define another and different and unpatented invention as existing in a combination, the first element of which is sectional pieces of the composite pipe defined in the patent claims, and the second element of which is (d) a particular means for joining the sections together in such manner to, and for the purpose of, producing joints between the sections, which joints (e) shed exterior moisture and are leak proof, and in which the completed joints between adjacent ends of adjoining sections are in substantial radial alignment; also (f) that thereby each string of connected pipe is independently supported and maintained in connected relationship, and further and independent of the thus claimed combination between the sections and the connecting means, these disclaimer claims specify a particular

attribute of a particular form of insulating material not a part of the patent claims, i. e., (g) that the insulating material between the two pipes of the sections shall provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

For the sake of emphasis, as well as clarity, we repeat that the disclaimer claims would embrace the following, *not called for or comprehended by the patent claims*:—

- (1) that the composite pipe should be made in a plurality of sections;
- (2) that adjacent ends of the inner and outer pipes of each section shall have a particular mechanical element for connecting sections together, to wit: male and female ends, etc.;
- (3) that these connecting means shall be such that
  - (a) a joint is provided between the sections which sheds any exterior moisture, and
  - (b) that the completed joints are in substantial radial alignment;
- (4) that the respective outer and inner tubes of the connected sections shall be independently supported and maintained in connected relationship;
- (5) that the insulating material interposed between the two pipes shall be of such form and construction as to provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

In *Carson v. American Smelting & Refining Co.*, 4 F. 2d 463, 469, this Court said:—

“A disclaimer may never be resorted to for the purpose of materially altering the character of an invention. It can only be used to surrender some ‘separable matter, which can be excised without

mutilating or changing what is left standing.’ \* \* \*  
In *Cartridge Co. v. Cartridge Co.*, 112 U. S. 624,  
642, 5 S. Ct. 475, 485 (28 L. Ed. 828), it was said:  
‘A disclaimer can be made only when something has  
been claimed of which the patentee was not the orig-  
inal or first inventor, and when it is intended to limit  
a claim in respect to the thing so not originally or  
first invented.’ ”

*In limine*, we wish to stress the point that the question as to the validity of this purported disclaimer does not turn upon whether in some sense its effect was to narrow the patent claims 1, 2 and 3. Obviously, a combination which is limited to having four elements is a narrower combination than one which requires only three of the principal elements of a machine. But this is not the function of a disclaimer. To disclaim a combination comprised only of the three elements, and to attempt by disclaimer to substitute therefor a combination consisting of these three elements with a fourth element, is to state a different combination, and *not to cut out or excise a part of a claim* as authorized by the disclaimer statute. The mere fact that in a sense the effect of a purported disclaimer is to narrow the scope of the patent is not determinative of the legal question involved.—

“While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations originally appearing in claims 9 and 13 only when used in conjunction with a flywheel, it also operated to add the flywheel as a new element to each of the combinations described in the claims.”

(*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477.)

It is well settled that the disclaimer statute (1) does not permit the addition of a new element to a combination previously claimed whereby the patent originally for one combination is transformed into a new and different one for the new combination, and (2) that upon the filing of disclaimers the original claims are withdrawn from the protection of the patent laws and the public is entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. These are the exact rules applied by the Supreme Court in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 79 L. ed. 1005, and will be found at bot. of p. 490 of 294 U. S., and in 1st col. of p. 1014 of 79 L. ed., and 2nd par. of p. 492 of 294 U. S., and middle par. p. 1015 of 79 L. ed. A quotation from the opinion of the Court is reproduced in the Appendix hereto, pp. 8-10. See, further, *American Lakes Paper Co. v. Nekoosa-Edwards Paper Co., et al.*, 83 F. 2nd 847—C.C.A. 7 [Appendix, pp. 10-13]; *Lowell v. Triplett*, 17 F. Supp. 996 [Appendix, p. 13]; *Freuhauf Trailer Co. v. Highway Trailer Co.*, 67 F. 2nd 558—C.C.A. 6 [Appendix, pp. 13-15]. See, also, *Freuhauf Trailer Co. v. Highway Trailer Co.*, 54 F. 2nd 691 (D.C. Mich.); *General Motors Corp. v. Rubsam Corp.*, 65 F. 2nd 217 (C.C.A. 6). *Corn Products Refining Co. v. Penick & Ford*, 63 F. 2nd 26 (C.C.A. 7) [Appendix, pp. 15-18].

Appellee has asserted that what the disclaimer does is to introduce structural limitations for each of the three elements of the respective patent claims and that such disclaimer merely restricts the elements of the claim to what is shown in the patent and described in the specification. Appellee's position is (as heretofore stated) a denial that the disclaimer added any new element and is entirely based



upon the hypothesis that anything described in the specification or shown in the drawings of the patent is not a new element and can be added to the patent claims. This is clear error. The *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.* case demonstrates the utter fallacy of appellee's position. In that case the Supreme Court held "the fly-wheel claims" (Nos. 5, 7, 17, 18 and 19) invalid as not disclosing invention (Cf. 294 U. S. 479, 480, 79 L. ed. 1008). The issued disclaimer applied only to claims 9 and 13 (294 U. S. 488, 79 L. ed. 1013). It was the attempt *to add by disclaimer* the fly-wheel, (not only shown and described in the specification and drawings of the Vogt, *et al.* patent but claimed in claims 5, 7, 17, 18 and 19 thereof,) to claims 9 and 13 that was held an invalid disclaimer. So here, although, for example, the male and female joints or fittings are shown in the drawings and are described in the specification, these facts do not make them parts of the combination specified in the patent claims and the disclaimer statute does not authorize their addition to the patent claims, precisely as such facts did not authorize the addition of the fly-wheel to claims 9 and 13 in the *Altoona Pub. Theatres* case.

The principle was established in *McCarty v. Lehigh Valley Railroad*, 160 U. S. 110, 40 L. ed. 358, 361, that an element, (such as the fly-wheel in the case of the Vogt patent, or the male and female joints or fittings in the patent here in suit,) cannot be interpolated into a claim either for the purpose of making out a case of novelty or infringement.—

"\* \* \* There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are so described in the specification and exhibited in the drawings. It

is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement.” (160 U. S. at p. 116.)

The foregoing decision has been cited and followed in almost innumerable cases. An example is *U. S. Peg Wood, S. & L. B. Co. v. B. F. Sturtevant Co.*, 122 F. 470, where at p. 472 it is said:—

“The Lewis machine has a capacity for adjustment which the Pulsifer machine did not have, but that capacity for adjustment forms no part of the claim in issue, and is not referred to in the claim, and cannot now be imported into it for the purpose of enlarging and changing its general meaning and scope.”

This principle is recognized and applied in the *Altoona Publix Theatres, Inc.* case:—

“While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, *whereby the patent originally for one combination is transformed into a new and different one for the new combination.*” (294 U. S. p. 490.) (Emphasis ours.)

It is clear, therefore, that the Stadtfeld patent is invalid and the decree should be reversed upon this ground with instructions to the District Court to dismiss the complaint.

The Patent Is Void Because Appellee Unreasonably Neglected and Delayed in Filing the Disclaimer. There Was No "Inadvertence, Accident, or Mistake" in Stadtfeld's Asserting and Procuring the Grant of the Patent Claims; Said Claims Were Secured with the "Fraudulent and Deceptive Intention" Within the Meaning of the Disclaimer Statute.—

The beneficial and remedial privilege afforded a patentee by the disclaimer statutes is expressly limited.— "But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer." (*R.S.U.S. 4922-35 USCA, Sec. 71.*) Nor is he entitled to the benefits thereof if he has originally asserted or procured claims upon old inventions fraudulently and with deceptive intention within the meaning of the statute. Considering the Stadtfeld patent solely from the standpoint of appellee as though appellee was the inventor, and not the successor in interest of Stadtfeld, and bound by his acts and knowledge:

The patent in suit issued September 3, 1935 [III. 637]. This suit was filed July 27, 1936 [I. 6]. Appellant's answer was filed June 18, 1937 [I. 40] and pleaded the Savage, O'Toole, Aldrich, Meade, Hammill, and Welch patents [I. 30-31]. Appellee neglected and delayed until Feb. 25, 1938, to file any disclaimer [III. 638],—7 days over 8 months after such most formal notice of said prior patents and of their anticipation of the patent claims,—which anticipation was not questioned, but admitted by appellee. This delay was unreasonable within the requirements of said statute (*Otis Elevator Co. v. Pacific Finance Corp.*, 68 F. 2nd 665, 670—C.C.A. 9, in which the referred to delay "from the submissions of the exceptions to the District Judge" [68 F. 2nd, next to last par. p. 671]

was from Oct. 15, 1930 to May 1, 1931,—six months and 13 days, a shorter time than the unexcused delay in the case at bar). In *Ensten v. Simon Ascher & Co.*, 282 U. S. 445, 452-3, 75 L. ed. 453, 457, the Supreme Court quotes with approval from *Robinson on Patents*, p. 284:—

“The same principle which forbids a patentee to assert a right to more than he has actually invented compels him to disavow the right as soon as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved. The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury. DELAY BEGINS WHENEVER THE PATENTEE BECOMES AWARE THAT HE HAS CLAIMED MORE THAN HE HAS INVENTED OR DESCRIBED. In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his claim by the Patent Office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention.”  
(*Emphasis ours.*)

and further says (at 282 U. S. 453, 75 L. ed. 457):—

“Under this view, a patentee having procured allowance of an invalid claim may hold it in the face of the public for years (here nearly two years) with large possible advantage to himself and much injury to others. By the assertion of his apparent monopoly he may deter others from legitimate action and seriously prejudice the public. See *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 355, 26 L. Ed. 783, 785.”



As said by Judge Westenhaver in *Ensten v. Rich-Sampliner Co.*, 13 F. 2nd 132, 136:—

“In *Minerals Separation v. Butte, etc., Mining Co.*, 250 U. S. 336, 354, 39 S. Ct. 496, 63 L. Ed. 1019, a delay of 3 months and 17 days after final decision was excused, because the owners of the patent resided in a foreign country and war-time conditions then prevailing rendered communication slow and difficult. If foreign residence and war-time conditions must be invoked to explain a delay so brief, an unexplained delay of 2 years must certainly be held unreasonable.”

Considering the Stadtfeld patent next from the standpoint of the inventor Stadtfeld and his successor in interest, appellee: There was wilful default and fraudulent and deceptive intention on the part of Stadtfeld. Before any application for patent was made Stadtfeld entered the employ of appellant's predecessor in interest, Payne Furnace and Supply Company. No application for patent was then filed because that company had an examination made and secured a report by its patent attorney O'Connor that the composite pipe was not novel and patentable [see Defts. Ex. 12 – III. 882]. Note that this report refers to the O'Toole and other patents. It was shown to Stadtfeld by El Roy Payne, one of the officers of Payne Furnace and Supply Company. Payne and Stadtfeld discussed said patents more than a year prior to the application for the patent in suit [Payne – II. 610; Stadtfeld – II. 544]. Definite knowledge and notice was thus brought home to Stadtfeld that a composite pipe comprising the combination of an inner and an outer pipe with an insulating material



therebetween, the inner and outer pipes slidably or telescopically arranged with respect to each other, was old. This, however, was the claimed subject-matter asserted by Stadtfeld to be novel in the application for the patent in suit and the definition of the invention procured by appellant. Stadtfeld and his subsequent assignee (appellee) were charged with this knowledge and notice and with the act of fraudulently and deceptively claiming as new that which they knew and were notified was not new. The obvious purpose was to secure a claim thereon to threaten the public with a monopoly thereof. Clearly it was wilful default and neglect to claim that Stadtfeld was the original or first inventor of such combination of elements or to have procured the grant of the patented claims calling therefor.

There was no evidence, oral or documentary, either in any way attempting to explain or bearing upon this issue of delay or of wilful neglect or fraudulent or deceptive intention, and the lower court made no finding thereon. The Commissioner of Patents had no authority or jurisdiction to pass upon this question. His duty was simply to record the purported disclaimer. The situation is unlike that arising under the reissue statute, where an affidavit is required by the statute and by the Patent Office procedure negating such default or neglect or fraudulent or deceptive intention, which affidavit when accepted as sufficient by the Commissioner of Patents is ordinarily held by the courts as sufficient proof on this point in the absence of contradictory evidence.

The Patent Is Invalid Because by the Purported Disclaimer Appellee Has Attempted to Claim and Monopolize as the Patentable Invention the Subject-Matter of Claims Which Were Presented in the Application, Rejected and Cancelled, Whereby Appellee Became Estopped to Thereafter Assert Such Subject-Matter as Patentable Invention by Stadtfeld.—

Application claims 3, 4, 5 [III. 694] and additional application claim 8 [III. 698] embraced and distinctly claimed the so-called leak proof joints formed by crimping the ends of the pipe sections.

No reference whatever was made in the patent claims 1, 2 and 3 to any end fittings or any leak proof joints or any crimping of the ends. Stadtfeld “thus eliminated from his claim those things which were excluded by surrender of scope and of definition of his claimed combination. *Wright v. Yuengling*, 155 U. S. 47, 15 Sup. Ct. 1, 39 L. Ed. 64; *Roemer v. Peddie*, 132 U. S. 313, 10 Sup. Ct. 98, 33 L. Ed. 382; *Greene v. Buckley*, 135 Fed. 520, 68 C. C. A. 70.” (*Wilson & Willard Mfg. Co. v. Union Tool Co.*, 249 F. 729, 735 – C.C.A. 9.)

Furthermore, the particular joint forming means was in no manner interdependent upon the particular construction of the composite pipe or whether the respective inner and outer pipes are slidable or telescopic with relation to each other. Such an assembly of non-interdependent elements is an aggregation and not a patentable invention. (Cf. *Hailes v. Van Wormer*, 87 U. S. 353, 22 L. ed. 241; *Keystone Driller v. Northwest E. Corp.*, 294 U. S. 42, 50, 79 L. ed. 747, 752; *Powers-Kennedy Corp. v. Concrete M. & C. Co.*, 282 U. S. 175, 186, 75 L. ed. 278, 286; *Grinnell Washing Mach. Co. v. E. E. Johnson Co.*, 247 U. S. 426, 62 L. ed. 1196.)

The Mere Selection of the Old, Well Known Composite Pipe Construction of Patent Claims 1, 2 and 3 and the Selection or an Addition Thereto of the Old, Well Known Crimped Ends Forming Leak Proof Joints Was Mere Mechanical Skill and Cannot Amount to Invention. (*Ray v. Bunting Iron Works—supra.*)

In view of the rules of law and decision hereinbefore cited, it would seem supererogation to discuss the prior patents anticipatory of the patent claims as granted. As we have pointed out, the filing of the disclaimer, as stated by the Supreme and other courts in the opinions cited, is a solemn declaration that Stadtfeld was not the inventor of the combination particularly pointed out and distinctly claimed in any of the patent claims. However, if the Court desires,—unnecessarily,—to consider such prior art and patents, for an original determination of this admitted fact, we call the Court's attention to the patents to Savage No. 500,779 of 1893 [Defts. Ex. 4-C—III. 719]; O'Toole No. 878,014 of 1908 [Defts. Ex. 4-E—III. 727]; Hammill No. 311,750 of 1885 [Defts. Ex. 4-A—III. 712]; Aldrich No. 340,691 of 1886 [Defts. Ex. 4-B—III. 715]; Harvey No. 534,473 of 1895 [Defts. Ex. 4-D—III. 723]; Meade No. 1,428,294 of 1922 [Defts. Ex. 4-F—III. 731]; and Welch No. 1,927,105 of Sept. 19, 1933 [Defts. Ex. 4-G—III. 736]. The application for this latter patent having been filed Oct. 8, 1932, its anticipatory effect is therefore the date of the application. (*Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U. S. 390, 70 L. ed. 651.) As none of these prior patents were cited by the Examiner of the Patent Office during the negotiations for the Stadtfeld patent, the *prima facie* presumption of validity is thus overcome (*Mettler v. Peabody Eng. Corp.*, 7 F. 2d 56, 58—C.C.A. 9).

The O'Toole patent [Defts. Ex. 4-E - III. 727] shows a pipe specially designed as a furnace pipe and to prevent the rapid escapement of heat [patent, p. 1, ll. 21-28, III. 727], comprising an inner and an outer pipe. These pipes are concentrically located relative to each other [*Id.* ll. 32-35]. A sheet of asbestos or other non-heat-conducting material is located between these concentric pipes and the inner pipe is of such size relative to the outer pipe that it can be placed in proper position and proper contact with the asbestos sheet [*Id.* ll. 32-45]. Necessarily, the inner and outer concentric pipes, having asbestos interposed therebetween, form a tube operatively having the same function as the asbestos lining interposed between the inner and outer pipes of the Stadtfeld patent. Obviously, the outer and inner pipes are in slidable relation. O'Toole shows the composite pipe in sections [see Fig. 3, III. 726]. As we shall hereinafter point out when considering the question of unreasonable delay in filing disclaimer, this O'Toole patent was not one of the references before the Patent Office. It is our judgment that this patent was one of the impelling reasons why the disclaimer was filed. It was pleaded in the answer and it was made known to this defendant by defendant's attorneys. [See Defts. Ex. 12, III. 882.] This patent was also made known to and discussed with Stadtfeld by appellant's vice-president and general manager, El Roy Payne, at least a year before any application for patent was prepared or filed by Stadtfeld at the instigation of appellee [II. 610; Cf. Defts. Ex. 12, III. 882].

The Meade patent [Defts. Ex. 4-F, III. 730-31] shows a composite pipe. It is denominated a stove-pipe thimble, and when used as a thimble one use is to project through a floor or partition. The description is so full and definite



that a reading thereof clearly discloses that it is made up of inner and outer pipes telescopically arranged with insulating material between the inner and outer pipes. Likewise this patent was not cited by the Patent Office against the Stadtfeld application.

The Savage patent 500,779 shows a chimney smokestack or flue-pipe comprising an inner and an outer pipe. The inner pipe is described as preferably of copper, the outer pipe as of galvanized iron. Between these pipes there is a non-conductive packing of asbestos or mineral wool [see lines 57-61, III. 719]. Necessarily, the forcing of asbestos between the two pipes forms a tube operatively having the same function as the asbestos lining interposed between the outer and inner pipes in the Stadtfeld patent. Obviously, the outer and inner pipes are in slidable relation. The Savage patent shows the composite pipe made in sections. They must be slidable one with relation to the other to secure this relation of one with the other. A similar comparison of the showings of the other exhibits referred to will demonstrate their pertinency and the anticipation of the Stadtfeld claims as granted. However, inasmuch as this is an admitted fact,—a fact which appellee is estopped by the disclaimer from contesting,—we do not feel justified in extending this brief for further detailed consideration of these prior patents. These prior patents show means for connecting sections together, but do not show the specific male and female fitting construction originally claimed in original claims 3, 4, 5 and 8 of the Stadtfeld application which were rejected and cancelled, as hereinbefore pointed out. These claims 3, 4, 5 and 8 were rejected upon the patent to Bradbeer [Defts. Ex. 6-A, III. 778], as shown by the Patent Office actions [III. 701, 703, 705]. As Stadtfeld acquiesced in the



correctness of the holding that there was no patentable novelty therein, and cancelled these claims, he is now estopped to contend otherwise. If, however, the Court desires to independently examine this anticipation, the construction and mechanical parts will be readily comprehended from the patent description and drawings.

It was old in the art at the time Stadtfeld claims to have made his alleged invention for pipes to be joined together by means of male and female fittings and to thereby provide leak proof joints. An example is the Bradbeer Patent 390,438 [Defts. Ex. 6-A, III. 778]. This is the prior patent cited by the Patent Office Examiner in the prosecution of the Stadtfeld application, and clearly shows in the drawing that the adjacent sections of the composite pipe shown therein were so joined by such means. The Meade Patent 1,428,294 [Defts. Ex. 4-F, III. 729] shows a stove-pipe thimble comprising two telescoping sections joined together by male and female fittings. The Line Patent 690,744 [Defts. Ex. 6-C, III. 787] shows the adjoining sections of the air-conducting tubes joined together by male and female joints. The same construction is also shown in Line Patent 696,059 [Defts. Ex. 6-D, III. 790]. Defts. Ex. 1 comprises depositions taken in Los Angeles on behalf of appellant. The photograph, Exhibit D thereto [III. 689] shows a vent pipe which was common construction in Los Angeles, California, for many years prior to the claimed date of the Stadtfeld invention. The numeral 4 on said photograph was placed thereon by appellee's counsel for the purpose of showing that two sections of the vent pipe were joined together by male and female joints [I. 153-54]. Furthermore, it was old, common practice to join two sections of vent pipe together by male and female joints in such a manner that any moisture condensing with-

in the pipe would not run out through the joints but would run down inside the pipe. Defts. Ex. 24 [III. 903] is Bulletin No. 302 distributed by appellant early in 1932, concededly antedating Stadtfeld's invention as a printed publication. On p. 3 of said Bulletin [III. 905] the instructions are that in installing a new vent, "The female end of each section must look UP \* \* \* This method of installing prevents any of the moisture condensing in the pipes from running out of the joints." It is thus seen that appellant prior to the Stadtfeld invention had published and disclosed to the public not only the necessity for, but the means of, joining together sections of pipe by male and female joints in such manner that any condensates would flow to the inside instead of the outside of the pipe. This is exactly what is shown in the drawings and described in the written specification of the Stadtfeld patent,—*although not claimed in the claims as granted*,—which appellee is attempting to recapture by reframing new and different claims by the purported disclaimer. Defts. Ex. 24 does not disclose or describe the manner in which the sections of the outer pipe are joined together. It would be obvious, however, from the disclosure how to cause moisture condensates to flow to the outside of the outer pipe, in the same manner as disclosed for the inner pipe.

With this common knowledge existent in the prior art, it clearly would not rise to invention to select the male and female joints, as described in the disclaimer, to join together the old, well known composite pipes shown in the Savage Patent 500,779, the O'Toole Patent 878,014, or the Meade Patent 1,428,294. The knowledge and skill of the workman in the art is sufficient to enable him without creative genius to make such selection, and even if the claims could be adjudged to have been lawfully reframed

and restated by the disclaimer, it is clear that they are void for anticipation and want of invention.

Not only does the record disclose, by the prior patents heretofore cited, that a composite pipe as defined in the patent claims was old, but the depositions taken on behalf of appellant at Los Angeles [I. 86, *et seq.*] establish that it had long been the practice to install composite pipe for carrying flue gases, such pipe consisting of an inner pipe of metal, an outer pipe of metal, and a corrugated galvanized tin spacer therebetween. The space between the inner and outer pipe was air space with the exception of the area taken up by the spacers. Several installations prior to 1932 were established beyond doubt. A typical one is that established by the testimony of Ben Henry Baker, a plumber, at present manager for J. Hokom Plumbing Company of Los Angeles [I. 118]. Mr. Baker testified that he installed the vent pipe shown in Exhibit D to Exhibit 1 [III. 689] in 1923 [I. 121-23]. That he has continuously lived in said house and that the said installation has not been changed. The inner pipe of that installation is slidable with reference to the outer pipe [I. 127]. Reference to the photograph [III. 689] will clearly indicate that with the exception of the insulating material (old and well known in the art), all the elements of the patent claims are present. The insulating material would have the same purpose and effect if inserted between the outer and inner pipe of the Baker installation as the insulating material shown in the various prior art patents heretofore referred to and no invention would reside in substituting for the corrugated galvanized iron spacer a well-known insulating material such as asbestos, mineral wool, etc. This selection of the preferred form of elements from old prior art structures, including as it does the leak proof joints before

discussed, clearly brings the case within the rule applied by this Court in *Ray v. Bunting Iron Works (supra)* and is further illustrated by the judgment of the Patent Office Examiner.

As said by the Patent Office Examiner in his official action in again rejecting claim 8:—

“Claim 8 is again rejected on the reference to Bradbeer, as being fully met thereby. As the Examiner reads this reference and the claim, the Bradbeer reference shows applicant’s exact coupling means, except for a reversal of parts. If the pipe of Bradbeer were reversed, that is, the bottom end of his pipe put at the top and the top end put at the bottom, the joints would be in the same relation as set forth in the claim. It is held the pipe of Bradbeer could be so reversed without the exercise of invention.”

[III. 705],

which action of rejection was repeated by the Patent Office Examiner after considering the arguments on behalf of Stadtfeld [III. 708].

### Conclusion.

Appellant submits:

(1) That the interlocutory decree granting an injunction is erroneous in law and should be reversed.

(2) That the attempted transformation of the claims of the patent by the disclaimer “is plainly not within the scope of the disclaimer statute”; that the attempted disclaimer is void; that “with the invalid disclaimer must fall the original claims as they stood before the disclaimer”, and that this patent stands before the Court void (*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.—supra*).

(3) That the patent in suit is void because appellee unreasonably neglected and delayed in filing a proper disclaimer; that there was unreasonable neglect and default both on the part of Stadtfeld and appellee, and the act of claiming the combination of patent claims 1, 2 and 3, with full knowledge that such combination was old and not the invention of Stadtfeld, was with fraudulent and deceptive intention and did not occur by reason of inadvertence, accident, or mistake.

(4) That it did not require the exercise of the inventive faculty to merely select the old well-known composite pipe construction (consisting of an outer pipe, a layer or layers of insulating material within the outer pipe, and a pipe inside the insulating material, the pipes slidably or telescopically arranged) and an old well-known leak proof joint (*Ray v. Bunting Iron Works — supra*). The patent is void for want of invention.

(5) That the decree or judgment of the District Court should be reversed with costs and with instructions to dismiss appellee's complaint with costs to appellant.

Respectfully submitted,

LYON & LYON,

FREDERICK S. LYON,

R. E. CAUGHEY,

*Attorneys for Appellant.*







## APPENDIX.

[II. 616-620]

In the United States Circuit Court of Appeals for the Ninth Circuit.

Payne Furnace and Supply Company, Inc., Appellant, vs. Williams-Wallace Company, a corporation, Appellee. No. 9327.

### CONCISE STATEMENT OF POINTS UNDER RULE 19(6) OF THIS COURT.

Notice is hereby given that at the hearing of this appeal the appellant will rely on the following points:

#### Point One.

The Stadtfeld patent 2,013,193 is invalid:

(a) because anticipated by the prior art patents pleaded as anticipations and in evidence herein;

(b) for want of patentable invention in view of the state of the art as exemplified by the prior patents in evidence and the prior public uses by Baker, Shearer and Evans established by the testimony herein;

(c) because by filing the so-called disclaimer of February 25, 1938, appellee has disclaimed claims 1, 2 and 3 of said patent as granted by the Patent Office, and said purported disclaimer is void in law as not within the disclaimer statutes, and the attempted disclaimer is void thereunder because in effect attempting to secure thereby a new patent for a new and different combination of elements from the combination or combinations called for by said claims 1, 2 and 3 of said patent as granted;

(d) because by said purported disclaimer appellee has attempted to assert patentable invention in the subject-

matter of claims of invention made in the application for said letters patent, rejected by the Patent Office and canceled by the applicant, (for example, rejected, canceled and abandoned claim 8 presented during the prosecution of the application for said patent,) and appellee is estopped to so assert;

(e) because appellee unreasonably neglected and delayed in filing said disclaimer.

The District Court's holding predicated upon findings of fact Nos. 7 to 16, inclusive, that said patent as to claims 1, 2 and 3 with disclaimers is good and valid in law, is therefore in error and said findings are contrary to the evidence and proofs herein.

#### Point Two.

The District Court erred in failing to find that Jacob A. Stadtfeld did not make the invention of the patent in suit until on or about May, 1933, as shown by the correspondence between said inventor and the defendant, in evidence under the group of letters, Plaintiff's Exhibit 10.

Findings of fact Nos. 24 and 25 are therefore in error and contrary to the evidence and proofs herein.

#### Point Three.

The District Court erred in holding that the defendant does not have either a shopright and implied license or an express license under said patent, and in not finding, as established by the evidence and proofs herein, that Henry A. Dutton and Jacob A. Stadtfeld on September 2, 1933, entered into a contract (Plaintiff's Exhibit 10) wherein and whereby they joined in the joint enterprise of manufacturing and selling devices embodying said Stadtfeld's alleged invention purported to be subsequently

covered by said Stadtfeld patent 2,013,193; that thereafter said Henry A. Dutton abandoned any right he might have asserted to the alleged Stadtfeld invention by abandoning the said joint enterprise and the manufacture of devices embodying the said invention and released and acquitted said Stadtfeld from any obligation under said Plaintiff's Exhibit 10 agreement; that with said Dutton's knowledge, consent, instigation, and subsequent ratification, said Stadtfeld entered into an agreement with defendant to employ Stadtfeld and to enter upon the business of manufacturing and selling said invention; that pursuant to said agreement with said Stadtfeld, defendant did enter upon and continue in the business of manufacturing and selling devices embodying the said invention and did invest material sums of money in said enterprise, and performed all of the terms of its agreement with said Stadtfeld fully, and paid all moneys due thereunder to said Stadtfeld so long as said Stadtfeld remained in defendant's employ; that said Stadtfeld breached said agreement by abandoning employment with defendant and leaving defendant's employ substantially without notice, and without any default of defendant; that appellee, as the successor-in-interest of said Stadtfeld and of said Dutton, is bound by said agreement so made by said Stadtfeld with defendant, and prior to acquiring any right, title, or interest in said alleged Stadtfeld invention or patent had full knowledge and notice of said agreement and of defendant's said rights, and defendant is entitled to the full performance of its agreement with said Stadtfeld. That therefore defendant possesses the continuing right to manufacture and sell devices embodying said invention, and such manufacture and sale thereof by defendant is not in infringement of said patent or any rights of appellee thereunder.



Findings of fact Nos. 29-36, 38-49, 51, 54, and 55, upon which the District Court's said holding is predicated, are therefore in error and contrary to the evidence and proofs herein.

Point Four.

The District Court erred in failing to hold that the defendant had the right to use and to sell to others devices embodying the invention of the patent in suit without liability therefor, pursuant to the provisions of 35 USCA, Sec. 48.

Point Five.

The District Court erred in holding the patent in suit valid as to claims 1, 2 and 3, and in failing to dismiss the bill of complaint. Infringement was admitted if the patent was valid.

Wherefore, appellant prays that said Decree be reversed, with directions to the court below to dismiss the bill as to appellant, with its costs.

LYON & LYON,

FREDERICK S. LYON,

REGINALD E. CAUGHEY,

*Attorneys for Appellant.*

(Endorsed): Filed Oct. 10, 1939. Paul P. O'Brien,  
Clerk.

*R. S. U. S. 4917 (35 USCA, Sec. 65).*

“Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.”

*R. S. U. S. 4922 (35 USCA, Sec. 71).*

“Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or

discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.”

*R. S. U. S. 4916 (35 USCA, Sec. 64).*

“Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several

patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.”

*R. S. U. S. 4888 (35 USCA, Sec. 33).*

“Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particu-

larly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor.”

*R. S. U. S. 4899 (35 USCA, Sec. 48).*

“Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.”

*Altoona Publix Theatres, Inc., v. American Tri-Ergon Corp., 294 U. S. 477, 489-92, 79 L. ed. 1005, 1013-15.*

“While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations originally appearing in Claims 9 and 13 only when used in conjunction with a flywheel, it also operated to add the flywheel as a new element to each of the combinations described in the claims. The disclaimer is authorized by Rev. Stat. Sec. 4917, which provides that when ‘through inadvertence, accident, or mistake . . . a patentee has claimed more than that of which he was the . . . inventor . . . his patent shall be valid for all that part which is truly and justly his own,’ provided that he or his assigns ‘make disclaimer of such parts of the thing patented as he shall not chose to claim . . . stating therein the extent of his interest in such patent.’ While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed,



where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination.

“If a change such as the present could validly be made, it could only be under the provisions of the reissue statute, Rev. Stat. Sec. 4916, which authorizes the alteration of the original invention in a reissued patent, upon surrender of the old patent, for its unexpired term. Upon the reissue ‘the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are.’ A patent amended by disclaimer thus speaks from the date of the original patent, while the re-issued patent, with respect to the amended claim, speaks from the date of re-issue. If respondent could thus, by disclaimer, add the flywheel to the arcuate flexing claim and to the optical claim, he would in effect secure a new patent operating retroactively in a manner not permitted by the re-issue statute and without subjecting the new claims to revision or restriction by the customary patent office procedure required in the case of an original or re-issued patent. Such transformation of a patent is plainly not within the scope of the disclaimer statute, and the attempted disclaimer as applied to Claims 9 and 13 is void. *Hailes v. Albany Stove Co.*, 123 U. S. 582, 587, 31 L. ed. 284, 286, 8 S. Ct. 262. See *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U. S. 624, 642, 28 L. ed. 828, 833, 5 S. Ct. 475; *Collins Co. v. Coes*, 130 U. S. 56, 68, 32 L. ed. 858, 862, 5 S. Ct. 514. Compare *Grant v. Walter*, 148 U. S. 547, 553, 37 L. ed. 552, 556, 13 S. Ct. 699. It is unnecessary to consider whether the flywheel claim, if added to the

original Claims 9 and 13, is such a part of the patentee's original conception as to entitle it to the benefit of the re-issue statute. See *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 355, 26 L. ed. 783, 785; *Hoffheins v. Russell*, 107 U. S. 132, 141; *Gage v. Herring*, 107 U. S. 640, 645, 27 L. ed. 601, 603, 2 S. Ct. 819; *Ives v. Sargent*, 119 U. S. 652, 663, 30 L. ed. 544, 548, 7 S. Ct. 436; *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U. S. 38, 41-43, 37 L. ed. 989, 990, 991, 14 S. Ct. 28.

“With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, ‘choose to claim or hold by virtue of the patent.’ Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public.”

(294 U. S. 489-492, 79 L. ed. 1013-15.)

---

*American Lakes Paper Co. v. Nekoosa-Edwards Paper Co., et al.*, 83 F. 2nd 847—C. C. A. 7.

“It is further contended by appellant that the effect of the Cincinnati roll as an anticipation is overcome by two disclaimers filed by appellant as assignee of Seaborne. The first was filed on July 24, 1933, before the trial and

after the depositions establishing that defense had been taken. The original specifications provided that the designs on the outermost cover, h<sup>2</sup>, should be ground, formed or cut. None of the claims said anything about how the design should be imparted to the outer surface. In the Cincinnati roll the design was formed by molding. This disclaimer seeks to distinguish the patent from the Cincinnati roll by eliminating the word 'formed' from the specification and by converting the claimed invention from the one originally covered to one which consisted in applying a design to a marking surface by grinding or cutting as distinguished from forming. The District Court found that it had been common practice in the rubber roll art for many years, to produce surface designs either by grinding or cutting, or by molding, and that those methods had long been well recognized mechanical equivalents. The evidence fully supports this finding. The distinction sought to be raised by this disclaimer is not a sufficient basis for invention.

"The second disclaimer was filed after the District Court's decision upholding the Cincinnati defense. The Cincinnati roll was made up of a number of strips or sleeves vulcanized together at their edges, instead of being made of a single continuous piece as called for in claim 8. It will be noted, as hereinbefore stated, that Seaborne had referred to a permissible modification of his alleged invention, in that instead of the outer or marking roll being a continuous sleeve, it might be a series of marking plates, illustrated by certain figures referred to in the second disclaimer. The purpose of this disclaimer was to eliminate these figures and all parts of the specification relating to them; to eliminate from the scope of each and all of the claims any marking roll whose engraved hard rubber cover was not continuous; and to limit the scope

of each and all of the claims to a marking roll with a single one-piece outer hard rubber sleeve in which the design was engraved. It is further to be noted that the original patent stated that the designs should be 'ground, formed, or cut;' the first disclaimer eliminated the word 'formed;' and the second disclaimer eliminates the words 'ground' and 'cut' and inserts the word 'engraved,' which is nowhere found in the original patent.

"It is clear that the Cincinnati roll, although made up of several sections, constitutes a continuous outer sleeve or cover. It is urged by appellant that its outer surface without seams is better for 'all over' designs such as spider webs and the like, but nowhere in the patent is an 'all over' design mentioned. Even so, it would hardly amount to invention to eliminate a vulcanized joint.

"We are convinced that the disclaimers purport to change the character of the invention for which the patent was originally granted, and for that reason, among others, we think the claims are invalid. The filing of the disclaimers was an effort to avoid the clear anticipation of the Cincinnati roll, and it has resulted in a defeat of the claims of the patent under the rulings in the following cases: *Altoona Public Theatres, Inc., v. American Tri-Ergon Corporation*, *supra*; *Hailes v. Albany Stove Co.*, 123 U. S. 582, 8 S. Ct. 262, 31 L. Ed. 284; *Fruehauf Trailer Co. v. Highway Trailer Co.* (D. C.) 54 F. (2d) 691, affirmed (C. C. A.) 67 F. (2d) 558; *General Motors Corporation v. Rubsam Corporation* (C. C. A.), 65 F. (2d) 217; *Corn Products Refining Co. v. Penick & Ford* (C. C. A.), 63 F. (2d) 26; *Albany Steam Trap Co. v. Worthington* (C. C. A.), 79 F. 966. The District Court's ruling was right in holding the claims invalid for anticipation and lack of invention." (p. 851.)



*Lowell et al. v. Triplett et al.*, 17 F. Supp. 996.

“Thus it must be concluded that claim 1 discloses no new hum-eliminating means, and that, if section (c) relating merely to the method of effecting grid bias be eliminated, it is identical with the disclosures in the articles by Moye and Dr. P. C., and therefore would be void for anticipation. How, then, must we treat the effect of the inclusion of section (c)? As we have seen, it discloses something which is novel, but that novelty is not part of the claimed invention which is the elimination of hum. However, further elaboration of this distinction appears to be unnecessary, because it is certainly clear that section (c) renders the whole claim void because it is not merely new in the sense that it is an invention, but it is a new part of the claim, inserted for the first time by the disclaimer. That is to say, it cannot, as we have seen, be considered as part of a plurality of means ‘for eliminating the hum of said alternating current in said apparatus,’ because it is not a hum-eliminating means, but a means for effecting grid bias. We have seen that the disclaimer rule prohibits the introduction, without invalidating the original claim, of anything not embraced in the original claim. Claim 2, of which claim 1 is typical, is likewise invalid.” (p. 1009.)

---

*Fruehauf Trailer Co. v. Highway Trailer Co.*, 67  
F. 2nd 558—C. C. A. 6.

“We quite agree with the views expressed by the learned trial judge upon the subject of the disclaimers. The enactment of Rev. St. Sec. 4917 (35 USCA Sec. 65), was never intended to permit the revamping and rephrasing of claims to the end that they might cover structures upon which they did not before read, or to the end that, by the



addition of a new element in combination, the disclaimer might validate a claim which would otherwise be invalid under the prior art. This is not limiting the combination already claimed; it is in effect claiming a new and a different combination. *General Motors Corp. v. Rubsam Corp.*, 65 F. (2d) 217 (C. C. A. 6); *Linville v. Milberger*, 34 F. (2d) 386, 390 (C. C. A. 10); *Albany Steam Trap Co. v. Worthington*, 79 F. 966, 969 (C. C. A. 2). The function of a disclaimer is well stated in the leading case of *Hailes v. Albany Stove Co.*, 123 U. S. 582, 587, 8 S. Ct. 262, 265, 31 L. Ed. 284. It must cover 'a separate claim in a patent, or some other distinct and separable matter, which can be excised without mutilating or changing what is left standing.' It cannot be used to change the character of the invention, or, in effect, to make for the patentee a new patent. This is fundamental. As to the distinction between disclaimer and reissue, we approve and adopt the position of the Circuit Court of Appeals for the Second Circuit that such 'distinction is between disclaiming a part separated in the patent itself as opposed to something comprehended in its general language.' *Grasselli Chemical Co. v. National Aniline & Chemical Co.*, 26 F. (2d) 305, 310 (C. C. A. 2). Compare also *Corn Products Ref. Co. v. Penick & Ford*, 63 F. (2d) 26, 30 (C. C. A. 7); *Strause Gas Iron Co. v. William M. Crane Co.*, 235 F. 126, 130 (C. C. A. 2); *Hudson Motor Car Co. v. American Plug Co.*, 41 F. (2d) 672 (C. C. A. 6).

"Tested by these standards, both disclaimers are invalid. That to the first patent disclaims matter which

is not separated in the patent itself, and which in fact is not expressly referred to in the patent, and its obvious purpose is to add to the claim description the structural feature that the horizontal level of the platform upon the tractor shall be slightly higher than the plane of the lower surfaces of the 'skid-like member' when the trailer is uncoupled, whereby the supports which hold up the forward end of the trailer body, when so uncoupled, are raised slightly from the ground by the coupling operation itself, and may be lowered, before uncoupling, to receive the weight of the trailer body when the uncoupling operation is completed. There is nothing in the claims or in the specification to show that Borst did not have in mind an organization of elements analogous to that found in the French patent to Jagenberg, No. 355,154, June 10, 1905, where the planes of the fifth wheel coupling elements upon the tractor and the trailer are held at substantially the same height both when coupled and when uncoupled." (pp. 559-560.)

*Corn Products Refining Co. v. Penick & Ford, Ltd., Inc.*, 63 F. 2d 26—C. C. A. 7.

"Passing the questions of delay in filing and of the effect of the disclaimer as an admission of the invalidity of the original claims, we are of the opinion that the document here in question is not a valid disclaimer. The statute limits the amendment of claims through disclaimer to that which 'is a material and substantial part of a thing patented and definitely distinguishable from the parts claimed without right.' The Supreme Court, in *Hailes v.*

Albany Stove Co., 123 U. S. 582, 587, 8 S. Ct. 262, 265, 31 L. Ed. 284, construed the statute: 'A disclaimer is usually and properly employed for the surrender of a separate claim in a patent, or some other distinct and separable matter, which can be excised without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or even to change the form of a claim which is too broad in its terms; but certainly it cannot be used to change the character of the invention. And if it requires an amended specification or supplemental description to make an altered claim intelligible or relevant, while it may possibly present a case for a surrender, and reissue, it is clearly not adapted to a disclaimer. A man cannot, by merely filing a paper drawn up by his solicitor, make to himself a new patent, or one for a different invention from that which he has described in his specification.'

*\*Before a part of a patent is disclaimed it must first be claimed and it must be definitely distinguishable from the parts which the patentee is entitled to retain. There is a clear distinction between disclaiming a part separated in the patent itself as opposed to something comprehended in the general language. Grasselli Chemical Co. v. National Aniline & Chemical Co., Inc. (C. C. A.), 26 F. (2d) 305; Strause Gas Iron Co. v. William M. Crane Co. (C. C. A.), 235 F. 126. (p. 30.)*

\* \* \* \* \*

“The extent to which the device of altering claims by disclaimer is carried in this case will be seen when we

undertake to rewrite the claims by interpolating limitations in the parts which must remain if the claims are to survive. Claim 1 so rewritten is as follows:

“1. Improved method of manufacturing starch *from corn, in a system wherein the solubles formerly permitted to run to waste and the water separated from insolubles are recovered* which comprises subjecting the starch bearing material in water to separating operations for removing starch therefrom, *wherein starch and gluten are washed from bran in a sieve system which includes sieves having minute openings and wherein starch, gluten and water are separated from each other at a stage following the bran washing operation and wherein the separated starch is washed and wash water and solubles therefrom are included in the recovery, steeping the corn in a portion of the water which has been separated from the starch and gluten subsequent to a tabling operation, withdrawing the steep water and recovering the solubles therein, sterilizing another portion of the water separated from the starch and gluten, after use in these operations, using the same in similar operations on subsequently treated starch bearing material in connection with the necessary make-up water in effecting separations preceding the starch tabling operation, washing the starch after separation thereof and re-using the wash water as make-up water.*’ (The portions in italics represent the additions through the disclaimer—matters which it is asserted were left out of the claim by inadvertence, accident or mistake.) If an attempt is made to rewrite claim 18 to conform to the disclaimer, it will be found that sentences



cannot be constructed to combine the original claim and the disclaimer.

“The statute (R. S. Sec. 4888, 35 USCA Sec. 33) requires that a patentee shall particularly point out and particularly claim the part, improvement, or combination which he claims as his invention. The claim prescribed by the statute is for the very purpose of making the patentee define precisely what his invention is. The disclaimers here make the claims so indefinite, obscure, and ambiguous that they do not stand the statutory test. To sustain the disclaimer in this case will require us to go farther than any court has ever gone and to sanction a method of indirect amendment which nullifies the purpose of the statute. *\*Moreover, the disclaimer does not strike anything from the specification and the claims as modified by the disclaimer retain sterilization as a distinct step in the process.* In that respect the claims as modified by the disclaimer do not differ from the original claims.” (p. 31.)  
(\* ) (This portion of emphasis ours.)

---

*Ray et al. v. Bunting Iron Works*, 4 F. 2nd 214—  
C. C. A. 9.

“It is said that appellee’s carrier is not anticipated by any single patent; but it is not necessary to show complete anticipation in a single patent. The selection and putting together of the most desirable parts of different machines in the same or kindred art, making a new machine, but in which each part operates in the same way as it operated before and effects the same result, cannot be



invention; such combinations are in the nature of things the evolutions of the mechanic's aptitude rather than the creations of the inventor's faculty.' Huebner-Toledo Breweries Co. v. Mathews Gravity Carrier Co., 253 F. 435, 447, 165 C. C. A. 177, 189.

"In *Elite Mfg. Co. v. Ashland Mfg. Co.*, 235 F. 893, 895, 149 C. C. A. 205, 207, the same court said:

"The various elements shown in plaintiff's patent and mentioned in its respective claims are all found in the prior art, performing respectively the same function in the same way and producing the same result as in plaintiff's device. We are not unmindful that to combine old parts in such manner as to produce a new result by their harmonious co-operation may be patentable; but where the combination is not only of old parts, but obtains old results, without the addition of any new and distinct function, it is not patentable. There is no invention in merely selecting and assembling, as Burkholder did, the most desirable parts of different mechanisms in the same art, where each operates in the same way in the new device as it did in the old, and effects the same results.'

"To the same effect, see *Le Roy v. Nicholas Power Co.* (D. C.), 244 F. 955; *Specialty Manfg. Co. v. Fenton Manfg. Co.*, 174 U. S. 492, 19 S. Ct. 641, 43 L. Ed. 1058; *Burt v. Evory*, 133 U. S. 349, 10 S. Ct. 394, 33 L. Ed. 647."

